UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,054	09/07/2001	Gregory D. Thomas	36-1468	7815

7590   01/04/2005

Nixon & Vanderhye
8th Floor
1100 North Glebe Road
Arlington, VA 22201-4714

EXAMINER
REFAI, RAMSEY

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/936,054	THOMAS ET AL.
	Examiner	Art Unit
	Ramsey Refai	2154

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 September 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-11</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-11</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>02/07/2002</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-11 are presented for examination.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. The claim is directed to a data carrier and renders it non-statutory.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5.   Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

- Claim 1 recites the limitations "sending data" in line 11, "stored data" in line 15,

    "data being received" in line 17, "the received data" in lines 17-18, and "the data" in

    line 19.

- Claim 2 recites the limitations "step c) at said first computer" in line 1, "said data" in line 6, and "the received data" in line 3.

- Claim 8 recites the limitations "the data" in lines 2 and 3.

- Claim 9 recites the limitations "the received data" in line 8, and "said data" in line 11.

- Claim 10 recites the limitations "the data" in line 11.

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-7, 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Shima (U.S.

Patent No. 6,369,909).

8.   As per claim 1, Shima teaches a method of processing data for performing a printing

operation in response to a print request made by a first computer to a second computer in a

network of computers, the method comprising the steps of:

i) at said second computer:

a) accessing stored data associating one or more printer identifiers and/or application

program identifiers with each member of a set of network address ports **(column 19, line 64-**

column 20, line 22, column 21, lines 4-44, Figure 7, and column 19, lines 28-55);

b) receiving a print request from said first computer, said request comprising an

identification of one of said stored printer identifiers or application program identifiers **(column**

6, line 44- column 7, line 14);

c) identifying the network address of said first computer **(column 13, lines 45-49; this is**

inherent since a printer must first determine the host address in order to send a message to

the host); and

d) sending data required for said print request to the network address of the first computer

(column 24, lines 8-14; sending printer information back to host), using the port associated

with the printer identifier or application program identifiers identified in the request **(column 6,**

lines 44-55; shows a request that contains a network address, and column 7, lines 4-14;

describes that a network address can be a port within a device); and

ii) at said first computer:

a) accessing stored data defining an association between each member of the set of

network address ports and a printer and/or application program **(column 19, line 64- column 20,**

line 22, column 21, lines 4-44, Figure 7, and column 19, lines 28-55); and

b) in response to data being received via one of said ports, sending the received data to

the printer or application program associated, in accordance with said stored data, with the

network port from which the data was received **(column 19, lines 28-column 20, lines 22)**.

9.   As per claim 2, Shima teaches at step c) at said first computer:

in response to data being received via one of said ports associated, in accordance with

said stored data, with a printer, sending the received data to that printer **(Figure 7, column 9,**

lines 28-50); and

in response to data being received via one of said ports associated, in accordance with

said stored data, with an application program, causing said data to be displayed using that

application program **(Figure 25, Figure 23, image composer, column 31, line 54 –column 32,**

line 28, column 32, line 65-column 33, line12, and column 33, lines 47-65).

10.   As per claim 3, Shima teaches at step d) at said second computer:

sending the data required for said print request to the network address of the first

computer, using the port associated with printer name or application program name identified in

the request **(column 6, lines 44-55)**; and

in response to said request identifying an application program name, sending and

identification of the type of data being sent in addition to the data itself **(column 19, line 64-**

column 20, line 22 and column 32,, lines 1-17 and lines 35-49).

11.   As per claim 4, Shima teaches stored data accessed by said first computer associates only

printers with each of said set of network address ports and said stored data accessed by said

second computer associates only printer names with each of said set of network address ports

(column 1, lines 44-47, column6, lines 44-55, and Figure 7).

12.   As per claim 5, Shima teaches the stored data accessed by said first computer associates

only application programs with each of said predetermined set of network address ports and said

stored data accessed by said second computer associates only application program names with

each of said set of network address ports **(column 1, lines 44-47, column 19, line 64-column 20,**

line 22, Figure 25, and column 32, line 65-column 33, line 33).

13.   As per claim 6, Shima teaches the received data being sent to a printer or application

program the data is compressed and/or stored and/or transmitted to another computer **(column**

32, lines 2-11, and column 19, lines 1-55).

14.   As per claim 7, Shima teaches at said first computer of only accepting data from a

predetermined set of data types **(Figure 25 and column 34, lines 43-47)**.

15.   As per claim 9-11, these claims contain similar limitations as claim 1 above, therefore are

rejected under the same rationale.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

17.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (U.S. Patent

No. 6,369,909) as applied to claim 1 above, and further in view of Muratani et al (U.S. Patent

No. 6,061,451).

18.   As per claim 8, Shima fails to teach encrypting the data before sending it to the first

computer; and decrypting the data received at said first computer.

19.   However, Muratani et al teach a method for encrypting and decrypting data **(abstract,**

and column 3, 20-38). It would have been obvious to one of the ordinary skill in the art at the

time of the applicant's invention to combine the teachings of Shima and Muratani et al because

Muratani et al's use of encrypting and decrypting data in Shima's method would secure the data

sent by protecting unauthorized access during transmission of the data.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The

examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2154

RR
December 26, 2004

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100